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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/519,245	03/06/2000	Chaitanya Kanojia	2657.2001003	8263
21005	7590	04/06/2004	EXAMINER	
HAMILTON, BROOK, SMITH & REYNOLDS, P.C. 530 VIRGINIA ROAD P.O. BOX 9133 CONCORD, MA 01742-9133			CARLSON, JEFFREY D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/519,245

Applicant(s)

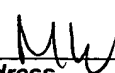
KANOJIA ET AL.

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 1/2/04.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-10, 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (US6446261) in view of Khoo et al (US6434747) and Marsh et al (US5848397). Rosser teaches methods of inserted downloaded advertisement material into a user's TV programming. The user's set top box monitors the users viewing behavior in order to develop a user profile. Ads are associated with required viewer profiles (group profiles) so as to target the ads to the appropriate users. Rosser stores the profiles locally. Khoo et al also teaches delivery of content over a data network and subsequent insertion of targeted ads to a TV viewer, based on the user profile. Khoo et al teaches the storage of the ad content and profile in a remote server which is provided with media transport service module acting as a bulk transfer manager and agent to access and download the content to the various users [col 6 lines 55-58]. It would have been obvious to one of ordinary skill at the time of the invention to have stored the profiles in a remote server as taught by Khoo et al. Khoo et al teaches that the client devices are instructed to only download content which matches the user profile and

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customizes media list; the entire collection of available content is not sent to the user, but only a portion based on the profile/customized media list. It would have been obvious to one of ordinary skill at the time of the invention to have downloaded only the customized content for each user, based on their profile, so that processing and resources are not burdened with downloading content that does not match the profile and will never be shown. Rosser and Khoo et al do not teach scheduling the downloading of ad collections. Marsh et al however also teaches systems for customized ads displayed to a user. Marsh et al teaches an advertisement distribution scheduler which determines which ads for which the client is eligible. The download scheduler determines when the ads are sent to each targeted user during a connection between the server and the client [3:27-30, 16:29-31, 16:51-53]. It would have been obvious to one of ordinary skill at the time of the invention to have provided and delivered scheduling of downloaded ads for each user device so that downloading of ads was optimized as taught by Marsh et al. Providing the file transfers of scheduled ads during such connections is taken to set forth generation and delivery of scheduling messages/commands instructing the client to download selected/targeted ad content. Downloading the content is taken to provide "activation" of the content, as it immediately becomes active/available for rendering by the client. Further, the delivery of the scheduling messages "to cause the devices to download and activate the content" as amended is taken to provide only functional language. Regarding the device addressing information, each profile that identifies a user is also taken to identify a device which has a device address in order to receive updated advertising. The

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scheduling of ad downloading is specific to a user/device. The system of Rosser provides signaling to the set top box to insert the appropriate ad (system manager functionality). Rosser teaches activation criteria of turning on the TV, for example [col 4 lines 60-64].

Regarding claims 8 and 9, Rosser also teaches switching channels as an event for ad activation/display.

Regarding claims 17-22, the connection which instructs the client to download the scheduled ads is taken to inherently provide a predetermined time/date as being the date/time the connection is established (i.e. current time). Likewise, the establishment of the connection to download scheduled content is taken to provide “an event” and “a start message.”

### ***Response to Arguments***

4. Applicant argues that Marsh et al requires waiting for the client to initiate a connection before content can be downloaded. Marsh et al teaches that scheduled ad content can be sent to the client “upon any connection between the client and the server” [16/28-29]. However, applicant’s arguments appear to be narrower than the scope of the claims. The claims do not require any particulars regarding the timing of the connection. Further, as stated above, the delivery of the scheduling messages “to cause the devices to download and activate the content” as amended is taken to provide only functional language.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on Mon-Fri 8:30-6p, (off on alternate Fridays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc